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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/081,257	02/22/2002	Jeffrey W. Mankoff	24124721.000008	2774

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EXAMINER	
CHAMPAGNE, DONALD	
ART UNIT	**PAPER NUMBER**
3622	

MAIL DATE	DELIVERY MODE
12/28/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/081,257	MANKOFF, JEFFREY W.	
	Examiner	Art Unit	
	Donald L. Champagne	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 October 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *53-90* is/are pending in the application.

4a) Of the above claim(s) *72-90* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *53-71* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *20 February 2002* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. A restriction requirement was erroneously mailed by the Office on 28 December 2007 and is hereby nullified.

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

   A. Claims 53-71, drawn to method, classified in class 705, subclass 14.

   B. Claims 72-90, drawn to apparatus (a database host), classified in class 709, subclass 223.

3. The inventions are distinct, each from the other because of the following reasons: Inventions A and B are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus/database host can be used for general computer network data management, for consumer online banking, for example.

4. Because these inventions are distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

5. On 26 December 2007, James H. Ortega, Esq., left a voice mail message for the examiner making a provisional election without traverse to prosecute the invention of A, claims 53-71. Affirmation of this election must be made by applicant in replying to this Office action. Claims 72-90 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 58 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In the last line, "third party" is indefinite because it is an ownership limitation.

8. Ownership limitations – Ownership is inherently indefinite because is not concrete: it is an indefinite, unpredictable property. Hence, in accordance with the *State Street* decision (MPEP 2106.II.A), ownership limitations cannot impart patentability. To illustrate the lack of predictability of "third party", suppose that the first and second parties each owned 50% of the entity operating the coupon system: would said operating entity be a "third party"? (Or would it be a 1-½ party?) Alternatively, suppose that some fourth entity owned 50% of the common stock of each of the three manufacturers, the store and the coupon system operator: which is the third party, or the first or second party for that matter?

Claim Rejections - 35 USC § 102 and 35 USC § 103

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. Claims 53-55 and 57-71 are rejected under 35 U.S.C. 102(e) as being anticipated by Hassell (US 20010042010A1).

12. Hassell teaches (independent claim 53) a method of managing virtual document merchant coupons, comprising:

a) establishing a network database (*database **20***) on a network-connected computer (*server(s) **10***, para. [0024] and [0021]), said network database corresponding to a plurality of consumers, the network database having data records (*folio for the user*, para. [0030] and [0031]);

b) receiving a first one of said virtual document merchant coupons (*coupon **700***, para. [0070] and Fig. 7) at said network-connected computer from a first document source (an *interactive television*, para. [0005] and [0065]);

c) identifying a consumer corresponding to the first received virtual document (the *registered user* whose *folio* contains the *coupon*, para. [0030]) and identifying a first enterprise associated with the first received virtual document (*sponsor's website*, para. [0071]) ;

d) storing information from the first received virtual document merchant coupon within the network database (para. [0071]) in a first data record associated with the identified consumer (a first *folder* within the consumer's *folio*, para. [0030] and [0031]), wherein the stored information includes the first enterprise identification stored in the first data record (para. [0071]);

e), f) and g): respectively repeating steps b), c) and d) for a second virtual document merchant coupon (*coupon **702***, para. [0070] and Fig. 7) from a second source/enterprise different from the first source (a different merchant), where a second *folder* within the consumer's *folio* (para. [0030] and [0031]) reads on a second data record associated with the identified consumer.

13. Hassell also teaches at the citations given above claims 54, 55, 57, 60-66, 69 and 71. Claim 70 was not given patentable weight because "enterprise identification" is nonfunctional descriptive material (MPEP § 2106.01).

14. Hassell also teaches: claim 58, where the coupon *image **35***, para. [0025], para. [0026] and Fig. 2, reads on "a banner ad"; claim 59 (para. [0051]); and claims 67 and 68 (para. 0069], where a *merchant coupon* can only be redeemed with said merchant).

15. Claims 56 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hassell. Hassell does not teach bulk email. Official notice is taken (MPEP § 2144.03) that it bulk email distribution of coupons was common at the time of the instant invention.

Conclusion

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

17. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 9:30 AM to 8 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717. The fax phone number for all *formal* matters is 571-273-8300.

19. The examiner's supervisor, Eric Stamber, can be reached on 571-272-6724.

20. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

21. **AFTER FINAL PRACTICE** – Consistent with MPEP § 706.07(f) and 713.09, prosecution generally ends with the final rejection. Examiner will grant an interview after final only when applicant presents compelling evidence that "disposal or clarification for appeal may be

accomplished with only nominal further consideration" (MPEP § 713.09). The burden is on applicant to demonstrate this requirement, preferably in no more than 25 words. Amendments are entered after final only when the amendments will clearly simplify issues, or put the case into condition for allowance, clearly and without additional search or more than nominal consideration.

22. Applicant may have after final arguments considered and amendments entered by filing an RCE.

23. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

Donald L. Champagne
Primary Examiner
Art Unit 3622

31 December 2007

DONALD L. CHAMPAGNE
PRIMARY EXAMINER